

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 54

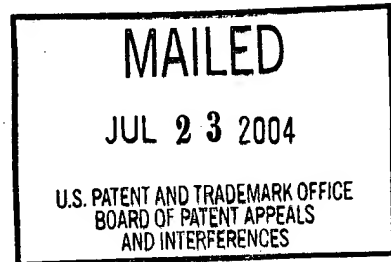
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RODNEY L. DOCKERY and CALEB J. PIRTLE

Appeal No. 2003-2005
Application No. 08/813,852

HEARD: April 14, 2004



Before JERRY SMITH, FLEMING, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

REMAND

This is a Remand in this application on appeal from the examiner's final rejection of claims 18-23 and 25 for the examiner to consider the Information Disclosure Statement which was filed by appellants on June 3, 2004, in response to our order mailed April 28, 2004. Claims 1, 4, 10, 17, and 26-28 stand withdrawn from consideration as non-elected claims.

BACKGROUND

Appellants' invention relates to a system and method for promoting stores and products. An understanding of the invention can be derived from a reading of exemplary claim 18, which is reproduced below.

18. A magazine for use in promoting the purchase of specific products, said magazine comprising:

a plurality of general interest articles dispersed throughout the magazine;

at least one of said articles making reference to an identified product, said at least one of said articles including within its confines specific brand information pertaining to said identified product; and

a coupon keyed to said at least one of said articles containing said brand specific information.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Shedd	2,215,163	Sep. 17, 1940
Bullard, Jr.	4,968,061	Nov. 6, 1990
Lamphere et al. (Lamphere)	5,127,674	Jul. 7, 1992

Claims 18, 22, and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shedd in view of Bullard, Jr. Claims 19-21, and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shedd in view of Bullard, Jr. in view of Lamphere.

OPINION

In reaching our decision in this appeal to remand the application, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the preliminary determination which follows.

In our Order, we noted that in the prosecution history, paragraph 5 of the Declaration (Paper No. 36) filed on Mar. 28, 2002, by Caleb J. Pirtle evidencing commercial success stated that:

[p]rior to October of 1997, Dockery House offered conventional promotional programs in which conventional promotional magazines which did not include the Dockery House invention would contain general interest articles, possibly recipes which may have included the brand-name of a product to be promoted, and cents-off coupons for some of the products to be promoted. However, as was the case with all previous promotional magazines of which I am aware, these conventional promotional magazines did not include coupons keyed to articles containing brand specific products.

At the oral hearing appellants' representative was asked if there was additional prior art that appellants may have knowledge concerning these conventional promotional magazines which would "contain general interest articles, possibly recipes which may have included the brand-name of a product to be promoted, and cents-off coupons for some of the products to be promoted." Appellants' representative was unsure of these prior promotional magazines and would look at the prior art submission to see if there

were disclosures with respect to support for this statement. Appellants filed a disclosure statement without further commentary. Therefore, we remand the application for the examiner to review these prior art magazines or conventional promotional magazines which would "contain general interest articles, possibly recipes which may have included the brand-name of a product to be promoted, and cents-off coupons for some of the products to be promoted."

From a cursory review, we direct the examiner's attention to pages 36 and 40 of Hawaiian Airlines magazine which discusses fitness and exercise programs/tapes. The Continental Airlines magazine at page 16 has a coupon for a booklet and map of Texas and page 52 has an article about a collection of art in Houston, Texas. Similarly there is an article about Cancún, Mexico at page 69 and an offer to purchase a video guide of Mexico at page 65. Additionally, there are a number of coupons, offers and recipes (e.g., pages 62 and 63) throughout the magazine for the examiner to consider.

CONCLUSION

To summarize, we have remanded this application to consider the prior art submitted by appellants in combination with appellants' declaratory evidence and the prior art of record. Upon consideration of this new prior art and any other art the examiner may deem appropriate, the examiner may maintain or modify the rejection as the examiner deems appropriate. After appropriate consideration and action by the

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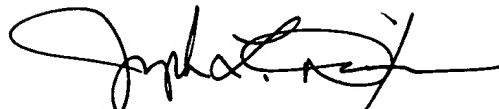
examiner, the examiner is to return the application to the Board for determination of this appeal on the merits.

REMANDED



JERRY SMITH
Administrative Patent Judge


MICHAEL R. FLEMING
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge

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